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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-------------------------|---------------------|------------------|
| 09/507,360 | 02/18/2000 | David Richard Gottstein | 3753/6 US | 8391 |
| 29858 | 7590 | 05/10/2004 | EXAMINER | |
| BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022 | | | BASHORE, ALAIN L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3624 | |

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,360

Applicant(s)

GOTTSTEIN, DAVID RICHARD

Examiner

Alain L. Bashore

Art Unit

3624

KW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-14,16-25 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-14,16-25 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, and 12-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 12, 21 and 23 there is recited "optimal" and "strategy path" which are considered vague and indefinite since no meets and bounds are defined for such terms.

In claims 1, 12, 21 and 23 there is recited "dynamic" which is considered vague and confusing as to the meets and bounds regarding a taxation time range which is inherently dynamic.

In claims 1, 12, 21 and 23 there is recited "sensitivity" which is considered vague and confusing as to the meets and bounds regarding a tax analysis.

Claims 12-22 recite "system" which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the

system claims belong to. For the purposes of this examination these claims are considered method.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 9, 12, 16, 19, 21, 23, 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank et al in view of Wallman in further view of Kiron et al.

Frank et al discloses a computerized method for optimizing investments. Tax and investment data is received corresponding to a plurality of investments. There are received user-customized investment expectations (col 5, lines 40-45). A comparative tax sensitivity analysis of the tax and investment data and the analyzed investment expectations are performed (col 10, lines 56-67; col 11, lines 1-6). There is outputted a set of financial investment data, including money valuations, representing an optimal after-tax investment strategy path from a plurality of investment paths over the dynamic taxation time range (col 1, lines 49-55). The investments may be bonds (col 5, lines 49-50). An input window is displayed on the user interface (fig 6).

There is not explicitly disclosed:

“lot-by-lot” basis or taxable “lots”;
derivative rights; and,
comparative pro-forma

Wallman discloses lots (col 1, lines 30-67; col 2, lines 1-21) and derivative rights (col 15, lines 15-23).

It would have been obvious to one with ordinary skill in the art to include a lot-by-lot basis including taxable lots to Frank et al because Wallman teaches that considerations of lots have important consequences for investors.

It would have been obvious to one with ordinary skill in the art to include derivative rights to Frank et al because Wallman teaches such a type of investment (col 15, line 15).

Kiron et al discloses comparative pro-forma (see abstract).

It would have been obvious to one with ordinary skill in the art to include comparative pro-forma to Frank et al in view of Wallman because Kiron et al teaches dissemination requirements to relevant parties (dissemination to shareholders).

5. Claims 2-4, 6, 13-15, 17, 22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank et al in view of Wallman in further view of Kiron et al as applied to claims 1, 5, 12, 16, 21, 23, 27-30 above, and further in view of Reed et al.

Frank et al in view of Wallman in further view of Kiron et al does not disclose:
a spreadsheet program with predetermined formula and predetermined cells of a spreadsheet grid.

Reed discloses a spreadsheet program with predetermined formula and predetermined cells of a spreadsheet grid.

It would have been obvious to one with ordinary skill in the art to include spreadsheet program with predetermined formula and predetermined cells of a spreadsheet grid to Frank et al in view of Wallman in further view of Kiron et al because Reed et al teaches spread sheets as useful and including as typical formulas, cells and grids (col 1, lines 13-42) and because Reed et al teaches such as common (col 1, line 9-10).

6. Claims 7-11, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frank et al in view of Wallman in further view of Kiron et al as applied to claims 1, 5, 12, 16, 21, 23, 27-30 above, and further in view of Howard et al.

Frank et al in view of Wallman in further view of Kiron et al does not disclose:

a GUI;

network-based entry window; and,

browser interfacing with server through the Internet or Intranet.

Howard et al discloses GUI (para 0027), network-based entry windows (para 0014), and browser interfacing with server through the Internet or Intranet (para 001).

It would have been obvious to one with ordinary skill in the art to include a GUI to Frank et al in view of Wallman in further view of Kiron et al because Howard et al teaches GUIs as common.

It would have been obvious to one with ordinary skill in the art to include a network-based entry window to Frank et al in view of Wallman in further view of Kiron et al because Howard et al teaches such as to allow sensitive information.

It would have been obvious to one with ordinary skill in the art to include a browser interfacing with server through the Internet or Intranet to Frank et al in view of Wallman in further view of Kiron et al because Howard et al teaches Internet use for information dissemination and that browser are common for this usage (para 003 and para 0011)

Response to Arguments

7. Applicant's arguments filed 3-1-04 have been fully considered but they are not persuasive.

The reference to Frank et al is utilized to show an optimal after-tax investment strategy path from a plurality of investment strategy paths over a dynamic taxation time range. The reference to Wallman is utilized for the lot-by-lot basis.

Frank, Wallman, and Kiron are all within the same field of endeavor - that of investment strategy.

Reed et al is within another same field of endeavor as Frank, Wallman, and Kiron – that of financial information output.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alain L. Bashore